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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,215	10/12/2001	Burghard Gruning	14885	9358

23389 7590 05/09/2003

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EXAMINER

LILLING, HERBERT J

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

## Application No.

09/976,215

## Applicant(s)

GRUNING ET AL.

## Examiner

HERBERT J LILLING

## Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 and 17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

1. Receipt is acknowledged of the election filed April 07, 2003.
2. Claims 1-17 remain pending in this application.
3. Applicant has elected with traverse, Group I, Claim 16 for examination with the species fatty acid is polyol that is ethylene glycol or propylene glycol. Applicant has traversed the restriction requirement which arguments have been deemed not to be persuasive. As indicated in the previous office action:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process of making e.g., by organic synthesis.

The prior art as indicated in the following rejections of the claimed subject matter clearly backs up this Examiner that the product as claimed can be made by another and materially different process of making as claimed in Invention I. The request as indicated on page 3 of the remarks

"Applicants submit that the claims in Groups I and II are interrelated and should be examined in a single application

because each of Claims 1-16 includes the generic processing steps recited in Claim 1."

has been denied in view of the fact that the search and examination requires a burden on this Examiner to search additional inventions which is not in compliance with the guidelines of the office. **Applicant may admit on the record** that if this Examiner finds one product within the scope of the elected invention, the processes of Group I invention would be prima facie obvious since the inventions are not distinct and independent. Upon receipt of this positive statement, this Examiner will be happy to reject the claims based on the current art of record submitted with this action. This Examiner abides by the guidelines of this Biochemical Tech Center, which includes the possibility of rejoining non-elected claims upon the allowance of any claimed product subject matter.

The restriction requirement has been made **FINAL**.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 16 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over

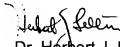
- a) Ansmann et al U.S. 5,863,461;
- b) Brown et al U.S. 5,288,619;
- c) Gunning et al U.S. 6,320,065; and
- d) Mitzutani U.S. 6,344,509.

Each of the references teaches mixture of reaction products that is within the scope of the claimed subject matter of hydroxy fatty acid esters, which are solids at room temperature. It is noted that it is immaterial whether or not the product(s) are enzymatically prepared [Brown et al or Gruning et al] or by organic synthesis [Ansmann et al or Mitzutani] absent a showing of any differences. Each of the references teaches the reaction of a component that contains at least two primary hydroxyl groups with a fatty acid component to form the claimed hydroxy fatty acid esters absent a showing to the contrary. It is noted that products of Mitzutani prepared in Examples 1-1 to 1-6 are presumed to be solids at room temperature absent a showing to the contrary. The polyols employed in Gruning et al that are within the scope of the claimed polyols are those, which contain terminal hydroxyl groups that includes the glycerols of the examples in the patent. Ansmann et al teaches the formation of mixtures of polyethylene glycols which are reacted with hydroxyfatty acids to form block polyesters that are within the scope of the claimed inventions absent a showing of a difference for the catalysts for the reactions.

5. **No claim is allowed.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is (703) 308-2034** and **Fax Number** is for applications **Before Final** (703) 872-9306 and **After Final** for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: H.JL  
(703) 308-2034  
Art Unit **1651**  
May 07, 2003

  
Dr. Herbert J. Lilling  
Primary Examiner  
Group 1600